

Appl. No. 10/679,027
Amdt. Dated December 24, 2004
Reply to Office action of 11/09/2004

REMARKS

Claims 1-13, 15-17, 19-25, and 27-35 are now pending in the referenced application. Dependent claim 18 is cancelled in this amendment, and dependent claims 14 and 26 were previously cancelled. A response to the Examiner's Detailed Action follows.

Claim Rejections - 35 USC 102

1. Claims 22, 23, 25, 27 and 28 have been rejected under 35 USC 102(b), as being anticipated by DeLessio et al. (USP 5,451,061).

2. Applicant respectfully notes that DeLessio's space labeled 46 is not a "trap space" in the same sense as cited in independent claims 22 and 25, wherein Applicant's method claim 22 cites a step of: "...removing from the game a piece that is moved into a one of the one or more trap spaces"; and apparatus claim 25 cites an element of the board game apparatus as: "one or more spaces that are identifiable as trap spaces for removing from the game a piece that is moved into a one of the one or more trap spaces". It should be clear from the detailed description (e.g., page 15, lines 15-16) that "removing" a piece from the game is a permanent action such that the removed piece cannot be used any more in the current game. In contrast, DeLessio's space 46 is merely the start of an alternate playing path for a playing piece which is not removed from the game in any sense. As stated in DeLessio's column 3, lines 20-28 (excerpted): "A third pathway 40 is located proximate the center of the board. This pathway represents the life of someone who is in jail. As with the other pathways, this oval path is made up of a plurality of consecutive spaces with most blank and a few marked.... This path begins at space 46 and ends at space 48." Therefore, Applicant respectfully submits that independent claims 22 and 25 should not be rejected under 35 USC 102(b), as being anticipated by DeLessio et al. As a consequence, Applicant is not amending claims 22 and 25 in response to Examiner's objections, and requests reconsideration of these claims in light of the above comments.

Claim 23 is dependent on claim 22, and therefore should be allowable if claim 22 is allowed. Furthermore, Applicant notes that claim 23 cites additional aspects of the invention (protecting a piece) that are not taught by DeLessio and therefore claim 23 should also be allowable if combined with the base claim 22 regardless of the status of claim 22.

In an action completely unrelated to Examiner's objections, Applicant wishes to further limit the citations of claim 22 (believed to be already allowable as argued hereinabove) by specifically citing which means are used for protecting a piece. This added limitation is supported by the original detailed description on page 20, lines 24-29; and also on page 21, lines 7-11.

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Claim 23, depending from claim 22, is made redundant by the amendment to claim 22, so the previous text is hereby replaced by text copied from claim 21, thereby further limiting the adjacency requirement such that the term "adjacent" is more narrowly defined to mean orthogonally adjacent (as opposed to, for example, diagonally adjacent, or for example, an adjacent space on a board not laid out in a rectangular array of orthogonally adjacent spaces arranged in rows and columns).

Regarding claims 27 and 28, since they depend from claim 25, they therefore should be allowable if claim 25 is allowed. Furthermore, Applicant notes that claims 27 and 28 cite additional aspects of the invention (piece types, manipulation, and a rectangular array of spaces) that are not taught by DeLessio and therefore claims 27 and 28 should also be allowable if combined with base claim 25, regardless of the status of the base claim. As a consequence, Applicant is not amending claims 27 and 28, and requests reconsideration of these claims in light of the above comments.

3. Claims 12, 13, 20 and 21 have been rejected under 35 USC 102(b), as being anticipated by Rechs (USP 5,690,332). Applicant notes that Rechs does not describe trap situations as stated by Examiner, but does describe a method for a player's piece to freeze an opposing player's piece (same column 3, lines 15-32 as cited by Examiner).

As Examiner has stated in paragraph 5 of the present Office Action, claim 18, which depends from claim 12, would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. It is further noted that claim 18 provides the limitation of only allowing a stronger piece to manipulate a weaker piece, unlike what is taught in the prior art such as Rechs. Consequently, Applicant hereby amends claim 12 to append all of the limiting text from claim 18 after the last clause of claim 12; thereby making the amended claim 12 allowable as an independent form of claim 18 with all the limitations of the base claim (claim 12).

As a consequence, claim 18 is cancelled because it is now redundant.

Further as a consequence, claim 19 is amended to change its dependence from claim 18 to claim 12 as is appropriate.

Allowable Subject Matter

4. Examiner has stated that claims 1-11, 24, and 30-35 are allowed. These claims are not amended herein.

5. Examiner objects to claims 15-19 and 29 as being dependent upon a rejected base claim. As discussed hereinabove, Applicant has herein amended the rejected base claim 12 so that it is now allowable, thereby making its depending claims 15-19 also allowable. Furthermore claim 29, which

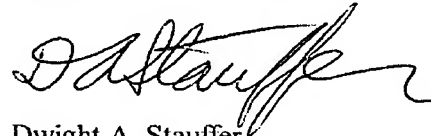
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depends in a chain from claim 25, should be considered allowable since the rejected base claim 25 is believed to be allowable as argued hereinabove.

Conclusion

The undersigned Agent of Record has made a sincere effort to amend the claims in response to the present Office Action. Favorable re-examination and consideration are respectfully requested.

Respectfully submitted,



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Date of Person signing : December 24, 2004